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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,380	08/30/2001	S. Grant Mulholland	10303-2 US	7757

7590 09/24/2003  
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EXAMINER

LAM, ANN Y

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 09/24/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/943,380	MULHOLLAND ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ann Y. Lam	1641	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-64 and 73-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-11, 13-25, 30-36, 39-42, 44-52, 57-64 and 73-75 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 12, 26-29, 37, 38, 43 and 53-56 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.


Claims 1-4, 8-11, 13-15, 18-23, 32-36, 39-42, 44-50, 58, 61, and 64 are rejected under 35 U.S.C. 102(e) as being anticipated by D'Augustine et al., 6,416,779.

As to claims 1, 33, 61 and 64, D'Augustine et al. disclose a base member (47) that is non-meltable; a reinforcement (44) that is non-meltable and has a length having a first end and a second end, said first end attached to said base member and projecting from said base member; and a meltable portion (i.e., medication in 43) formed around a portion of said length of said reinforcement, said meltable portion having a diameter which tapers from said second end toward said first end, see Figure 6.

As to claims 2, 34, the base member (47) is shaped for handling.

As to claims 3, 4, 35, 36, the base member (47) is ellipsoid.

As to claim 39, the base member (47) is sized to fit within the labia minora.



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As to claims 8, 13, 22, 40, 44 and 49, the suppository is comprised of polymers, see column 15, lines 18-22.

As to claims 9, 10, 41, the reinforcement first end is considered embedded within the base member, and projects perpendicular from said base member, see Figure 6.

As to claims 11, 42, the reinforcement (44) comprises a rod.

As to claim 14, the reinforcement is sized such that upon insertion into the urethra, the second end of the reinforcement is entirely within the meltable portion.

As to claim 15, the second end of the reinforcement (44) extends outside the meltable portion, see Figure 6.

As to claims 18-21, 45-48, the reinforcement (44) comprises a restraint.

As to claims 23, 50, the meltable portion comprises the therapeutic agents as claimed, see column 20, lines 39-43.

As to claim 32, 58, the meltable portion is capable of melting within about 2 minutes to about 60 minutes.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 25, 31, 51, 52, 57, 62, 63 and 73-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Augustine et al., 6,416,779.

D'Augustine et al. disclose the invention substantially as claimed (see above).

However, with respect to claims 16, 17, 24, 25, 30, 31, 51, 52, 57, 59, 60 and 73-75, D'Augustine et al. do not disclose the dimensions as claimed. However, it would have been obvious to form the meltable portion having the dimensions as claimed, as would be necessary to fit inside the vagina of patients of various sizes, as taught by D'Augustine et al.

As to claims 62 and 63, it would have been obvious to wait for about 1 minute to about 10 hours to deliver the therapeutic agent, as may be necessary to deliver the agent.

#### ***Allowable Subject Matter***

Claims 5, 6, 12, 26-29, 37-38, 43, 53-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the combination of elements including a grooved base member, or a roughened base member, or a reinforcement being comprised of a lattice or mesh, was not found in the prior art search.

#### ***Response to Arguments***

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Applicant's arguments with respect to the above claims have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is (703) 306-5560. The examiner can normally be reached on M-Sat 11-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703)305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0196.

A.L.



LONG V. LE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

09/22/03